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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,045	02/04/2004	Leif O. Erickson	56165US011	3924
32692	7590	07/02/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY				EGAN, BRIAN P
PO BOX 33427				ART UNIT
ST. PAUL, MN 55133-3427				PAPER NUMBER
				1772

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/772,045	ERICKSON ET AL.
	Examiner Brian P. Egan	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/12/04
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it exceeds the 150 word limit.

Correction is required. See MPEP § 608.01(b).

#### ***Claim Interpretation***

3. The claim 1 limitation "formed by a computer operated tape applicator and being applied to the first surface of the release liner by said tape applicator in a predetermined pattern" is directed at the method of forming the claimed article. The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sundet (#5,665,446).

Sundet discloses a laminate adapted for use to decorate a substrate, the laminate comprising a layer of pre-mask material with a cover layer and a layer of removable adhesive firmly adhered to one surface of the cover layer, display lengths of decorative film tape each comprising a length of decorative film having opposite major surfaces and a layer of adhesive along one of the major surfaces, and a release liner having opposite first and second major surfaces, the first major surface of the release liner is adapted to be releasably adhered to by the removable adhesive on the cover layer and by the adhesive on the decorative film. The display lengths of decorative film tape are cut out by a computer-controlled knife and implicitly may comprise different predetermined shapes and lengths (for example, the "W" in Fig. 1 varies in width along different portions of the letter and it is therefore implicit that other predetermined shapes and lengths are constructable). The layer of removable adhesive included in the layer of pre-mask material is adhered over the outer major surfaces of the display lengths of decorative film tape adhered to the release liner and to the release liner around the display lengths of decorative film tape. The decorative film has light reflecting layers within the decorative film ("filled with light diffusing agents, including flecks of aluminum-vapor-coated polyester film, to afford a frosted appearance" – Col. 5, lines 29-37). Since the decorative film is "filled with light diffusing agents," the decorative film has "other structures along the major surface of the decorative film opposite the layer of adhesive so that the decorative film visually simulates a decorative structure."

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sundet ('446).

Sundet teaches a laminate as detailed above. Although Sundet does not explicitly teach that some of the display lengths of decorative film have closely spaced ends with the spaces between the ends being in the range of 0.005 and 0.12 inch, Sundet does teach that the space between the vents in the pre-mask layer ranges between 0.04 to .4 inches (Col. 3, lines 16-24). It is clear from observation of Fig. 3 that portions of the "W" are spaced apart by only two vents, and thus it is implicit that the computer-controlled knife is capable of cutting display lengths that are spaced in the range of 0.04 to .4 inches, a range inclusive of values within the applicant's claimed range. Therefore, it would have been an obvious matter of design choice to provide display lengths of decorative film with ends spaced in the range of 0.005 to 0.12 inches.

Furthermore, modification of the distance between display lengths, absent demonstration of unexpected results, would have involved a mere change in size. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

8. Claim 3 is further rejected under 35 U.S.C. 103(a) as being unpatentable over Sundet ('446) in view of Futhey et al. (#5,840,407).

Although Sundet teaches one of the alternative embodiments claimed in claim 3, i.e., wherein the decorative film has an “other structure along the major surface of the decorative film,” Sundet does not teach the use of a grooved surface opposite the layer of adhesive. It is notoriously well known in the adhesive art to provide a substrate with a grooved surface for the purpose of simulating a leaded glass or beveled mirror appearance as evidenced by Furthey et al. (see Abstract). It would have been obvious to one of ordinary skill in the art at the time Applicant’s invention was made to have combined the teachings of Sundet and Futhey et al. since each of the aforementioned references are analogous insofar as being directed at adhesive decorative substrates that result in an appealing simulated appearance.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant’s invention was made to have modified Sundet to include grooves along the surface of the decorative film as taught by Futhey et al. in order to provide a substrate that simulates a leaded glass or beveled mirror.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BPE  
BPE 6/25/04

Harold Pyon  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

6/28/04